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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,610	06/15/2001	Peter M. Bergler	MS1-690US	8484
22801	7590	11/03/2006	EXAMINER SMITH, TRACI L	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/882,610	Applicant(s) BERGLER ET AL.	
	Examiner Traci L. Smith	Art Unit 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-30 and 32-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-30 and 32-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

This action is in response to papers filed on August 14, 2006.

Claims 1-2, 12, 16, 19, 30 and 40-41 have been amended.

Claims 1-4,6-30 and 32-55 are pending.

Claims 1-4,6-30 and 32-55 are rejected.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 35-40 and 43-49 rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 6,189,146 Misra et al. System and Method for Software and further in view of US Patent Publication 20030160823 A1 Stannard, Method and System for Indicating a license status of an object.

Art Unit: 3629

4. As to claims 35, 43 and 49 Misra teaches issuing a license with and expiration date and reissuing the licenses(C.3 I. 1-7 Table 1) Misra to teach a new expiration date for the renewed license. However, Stannard teaches a system and method of software licensing that when a user renew an old license they receive a new expiration date (Pg. 6 ¶ 73). Stannard also teaches the reissue in response to a reminder that the current license is about to expire therefore, therefore this indicates a period of time in which the user is allowed to updated the license. The examiner notes applicant merely states that update period is sometime before the expiration date, which allows the examiner a broad interpretation of this period. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Stannard with Misra so as continue use of the original license for an extended period of time. Neither Stannard or Misra explicitly teaches an update period it is inherent that if

5. As to claims 37, 42 and 46-47 Misra teaches issuing a new; requesting a new a new license when a new upgraded version is available(it's only available during a certain period of time0.(C. 16 I. 59-63) Determining if a license is lost and issuing a new license(C. 15 I. 13-16) Issuing a temporary license if new license is not available(C. 17 I. 8-12).

6. As to claims 36 and 44-45 Misra teaches a license request; reissuing a license when still available(C. 4 I. 54-57) Issuing a new license when old license is not available(C. 15 I. 19-25). Both dening and granting access to terminal dependent on security settings when license is not avaible.(CI 17 I. 19-21; C. 14 I. 10-11).

7. As to claims 10 and 26 teaches temporary licenses not being renewable(Cl. 17 l. 27-29).

8. As to claims 11, 14-15, 17-18, 27-29, 32-33 and 50-55 teaches the license issuing renewing and tracking taking place across a networked computer system(C. 4 l. 30-48)

9. Claims 38-40 and 48 rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 6,189,146 Misra et al as applied to claim s 1, 12, 30, 35, 41, 43 and 49 in view of obviousness.

10. As to claims 38-40 and 48 Misra teaches various time lines for issuing and expiring licenses(Table 1-5). A set temporary period (C. 17 l. 7-11) Although Misra fails to teach the exact length of a temporary period it would be obvious to one skilled in the art that when giving the temporary license a limit or a finite duration it would include making it 90 days. Although Misra fails to teach an upgrade period for a select time before expiration, it would have been obvious to one skilled in the art at the time of invention to make the period before the license expires to make it a simpler process for the user to renew the license. The examiner notes applicant merely states that update period is sometime before the expiration date, which allows the examiner a broad interpretation of this period.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3629

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-4, 10-12, 14-21, 26-30, 32-34, 41-42 and 50-55 are rejected under 35

U.S.C. 103(a) as being unpatentable over US patent 6,189,146 Misra et al. System and

Method for Software and further in view of US Patent Publication 20030160823 A1

Stannard, Method and System for Indicating a license status of an object as applied to

claims 35-40 and 43-49 above, and further in view of US 5745879 Wyman Method and

System of Managing and Execution of License programs.

14. As to claims 1, 12, 30 and 41, Misra teaches issuing a license with and

expiration date and reissuing the licenses(C.3 I. 1-7 Table 1) Misra to teach a new

expiration date for the renewed license. However, Stannard teaches a system and

method of software licensing that when a user renew an old license they receive a new

expiration date (Pg. 6 ¶ 73). Stannard also teaches the reissue in response to a

reminder that the current license is about to expire therefore, therefore this indicates a

period of time in which the user is allowed to updated the license. The examiner notes

applicant merely states that update period is sometime before the expiration date, which

allows the examiner a broad interpretation of this period. It would have been obvious to

one of ordinary skill in the art at the time of invention to combine the teachings of Stannard with Misra so as continue use of the original license for an extended period of time. Neither Stannard or Misra explicitly teaches an update period it is inherent that if the user has the option to update a license there is a time period for which to do the update. Neither Stannard or Misra teach **“returning the license back to an available period when not updated”** WYMAN teaches based on consumptive use a license is **“deallocated”** to a pool of available units(C. 15 I. 20-25). It would have been obvious to one of ordinary skill in the art at the time of invention to combine Stannard and Misra with Wyman so as to allow a corporation to continue to utilize all the purchased license rather than buying new ones and having other sit dormat.

15. As to claims 2, 19, 42 Misra teaches issuing a new; requesting a new a new license when a new upgraded version is available(it's only available during a certain period of time0.(C. 16 I. 59-63) Determining if a license is lost and issuing a new license(C. 15 I. 13-16) Issuing a temporary license if new license is not available(C. 17 I. 8-12).

16. As to claims 3-4, 20-21, Misra teaches a license request; reissuing a license when still available(C. 4 I. 54-57) Issuing a new license when old license is not available(C. 15 I. 19-25). Both dening and granting access to terminal dependent on security settings when license is not avaible.(CI 17 I. 19-21; C. 14 I. 10-11).

17. As to claims 10 and 26 teaches temporary licenses not being renewable(CI. 17 I. 27-29).

18. As to claims 11, 14-15, 17-18, 27-29, 32-33 and 50-55 teaches the license issuing renewing and tracking taking place across a networked computer system(C. 4 I. 30-48)

19. Claims 5-9, 13, 22-25 ejected under 35 U.S.C. 103(a) as being unpatentable over US patent 6,189,146 Misra et al as applied to claim s 1, 12, 30, 35, 41, 43 and 49 in view of obviousness.

20. As to claims 6-9, 13, 22-25 Misra teaches various time lines for issuing and expiring licenses(Table 1-5). A set temporary period (C. 17 I. 7-11) Although Misra fails to teach the exact length of a temporary period it would be obvious to one skilled in the art that when giving the temporary license a limit or a finite duration it would include making it 90 days. Although Misra fails to teach an upgrade period for a select time before expiration, it would have been obvious to one skilled in the art at the time of invention to make the period before the license expires to make it a simpler process for the user to renew the license. The examiner notes applicant merely states that update period is sometime before the expiration date, which allows the examiner a broad interpretation of this period.

### ***Response to Arguments***

21. Applicant's arguments filed August 14, 2006 with respect to claims 35-40 and 43-49 have been fully considered but they are not persuasive. The claims argued in this section are merely a server and a system, therefore the majority of the limitations are intended use of the system and server which do not functionally distinguish the claims from the prior art of record. Apparatus claims should cover what a device is or



structures or structural elements, not what a device does. See *Hewlett-Packard Co. vs. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

22. Applicant's arguments with respect to claims 1-4, 10-12, 14-21, 26-30, 32-34, 41-42 and 50-55 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

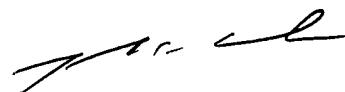
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

Art Unit: 3629

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLS



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